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10/564,361	07/21/2006	Etsuo Otobe	050849	8849

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EXAMINER	
CHAKOUR, ISSAM	
ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/564,361	OTOBE ET AL.	
	Examiner	Art Unit	
	ISSAM CHAKOUR	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1;3-6;13-15;21-23;and 29-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1;3-6;13-15;21-23;and 29-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 January 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to the amendments and arguments filed on 10/28/2008. The applicant amended claims 1, 13, 15, 22, and 23 in addition to presenting new claims 31-33. Claims 1, 3-6, 13, 21-23, and 29-30 have been fully considered and claims 31-33 are entered and considered.

Claims 1 and 3-6 have been amended to overcome deficiency of indefiniteness. The examiner accordingly withdraws the rejection under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

Claims 23, 29, and 30 are rejected under 35 U.S.C. 101; because these claims recite a "computer program" that is not explicitly disclosed to be associated with a computer readable medium which is non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 5, 6, 13, 14, 15, 21-23, 29, 31, and 32 are rejected under 35 U.S.C. 102 (b) as being anticipated by Katagishi et al (US 2002/0168997).

Regarding claim 1, 15, 23, and 31 Katagishi discloses a telephone, its corresponding method, and its corresponding computer program, comprising:

an acquiring unit (e.g. operation unit, item 107 in figure 1) operable to acquire a telephone number of a callee and region information relating to a/the locality of the callee (See figure1 and abstract);

a judging unit (e.g. the control unit) operable to judge (See figure 1) whether the telephone number is a telephone number satisfying a predetermined condition that enables international roaming (e.g. determining if the callee has contract of service which enables the caller to obtain time information outside the home region, see [0051] lines 16-21 on page 6) in a telephone network of a region in a different time zone (See paragraph [0007] and paragraph [0009], note that Katagashi's invention is directed towards providing time information about callees whose mobile station has roaming capability);

a storage unit operable to store the telephone number, identification information identifying the callee of the telephone number (See [0051] on page 6 lines 9-13), and the region information in association with each other (e.g. step 613, figure 15), based on a user operation (user operation are inputs to the operation unit as depicted in item 107 figure 1), if judged in the affirmative (See figure 15);

a calculating unit (also the control unit) operable to calculate a local time of the locality shown by the stored region information, with reference to the storage unit, if a user

operation selecting one of the telephone number and the identification information is performed (See figure 1 and abstract); and a display unit operable to display the local time (See item 106 in figure 1 as well as item 502 in figure 4).

2. Regarding claim 5, Katagishi teaches the telephone in accordance with claim1, wherein the region information is recorded in a location register (e.g. VLR which controls the base-station with whom the callee communicates) that manages a movement of the telephone of the callee in a telephone network (See figure 1 and claim 5), and the acquiring unit acquires the region information by receiving the region information transmitted from the location register via the telephone network (See claim 6).

3. Regarding claim 6, Katagishi discloses the telephone in accordance with claim 5, wherein the acquiring unit acquires the region information as a reply to a callout or a request to the telephone of the callee (See abstract), and the telephone further comprises:

a reception unit operable to receive a user operation after the display of the local time, the operation being one of approving and canceling a call (See paragraph [0009], lines 8-9); and

an instructing unit operable to instruct the telephone network to one of approve and cancel the call, upon receipt of the user operation (See figure 2 & 1).

4. Regarding claim 13, 21, and 29 Katagishi teaches a telephone system and its corresponding method and computer program comprising a telephone network for

managing a movement of a first telephone, and a second telephone for displaying a local time of a locality of the first telephone (See abstract),

the telephone network including:

a location registration unit (e.g. a VLR of the roaming first telephone which is inherent in roaming as discussed above) operable to record region information relating to the locality of the first telephone (See paragraph [0012] and claim3);

a reception unit operable to receive from the second telephone, specification information specifying the first telephone (claim 5); and

a notifying unit operable to notify the region information to the second telephone, upon receipt of the specification information (claim 11), and the second telephone including:

an acquiring unit or operation unit operable to acquire a telephone number of the first telephone (See figure 1 and claim 1 & 10);

a judging unit or control unit operable to judge whether the telephone number is a telephone number satisfying a predetermined condition that enables international roaming in a telephone network of a region in a different time zone (See figure 1 and claim 1 & 10);

a storage unit operable to store the telephone number, identification information identifying a callee of the telephone number, and the region information notified from the telephone network in association with each other, based on a user operation (user operation are inputs to the operation unit as depicted in item 107 figure 1), if judged in the affirmative (See figure 3 & 15);

a calculating unit or control unit operable to calculate the local time of the locality shown by the stored region information, with reference to the storage unit, if a user operation selecting one of the telephone number and the identification information is performed (See figure 1 and claim 1 & 6); and a display unit operable to display the local time (See item 106 in figure 1 as well as item 502 in figure 4).

5. Consider claim 32, Katagishi teaches a computer readable recording medium storing therein a computer program that causes a telephone system to execute display processing for displaying a local time of a locality of a first telephone (See [0010]), the telephone system including a second telephone provided with a storage unit (See [0013], lines 1-3) and a telephone network for managing a movement of the first telephone (See [0034], lines 1-6), the display processing comprising the steps of:
recording, in the telephone network, region information relating to the locality of the first telephone (See [0034], lines 10-15);
receiving, in the telephone network, specification information specifying the first telephone from the second telephone (See [0044], lines 2-5);
notifying, in the telephone network, the region information to the second telephone, upon receipt of the specification information (e.g. local time requests, see [0051] on page 6 lines 8-18, see also [0034] on page 3 lines 2-7);
acquiring, in the second telephone, a telephone number of the first telephone (See [0045], lines 3-8);

judging whether the telephone number is a telephone number satisfying a predetermined condition that enables international roaming in a telephone network (e.g. determining if the callee has contract of service which enables the caller to obtain time information outside the home region, see [0051] lines 16-21 on page 6) of a region in a different time zone (See [0044], lines 2-5);

storing, in the second telephone, the telephone number, identification information identifying the callee of the telephone number (See [0051] on page 6 lines 9-13), and the region information notified from the telephone network in association with each other in the storage unit (e.g. step 613, figure 15), based on a user operation (user operation are inputs to the operation unit as depicted in item 107 figure 1), if judged in the affirmative (See figure 15)

calculating, in the second telephone, the local time of the locality shown by the stored region information, with reference to the storage unit, if a user operation selecting one of the telephone number and the identification information is performed (See figure 1 and abstract); and

displaying, in the second telephone, the local time (See item 106 in figure 1 as well as item 502 in figure 4).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 3, 4, 14, 22, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katagishi.

9. Regarding claim 3, Katagishi teaches the telephone in accordance with claim 1. Although Katagishi does not explicitly teach the telephone wherein the acquiring unit receives in an audible frequency band from a telephone of the callee a modulation signal representing the region information, and acquires the region information by decoding the received modulation signal. The modulation and demodulation of signals carrying information between mobile units at conventional frequencies bands is a technique well known in the art. It would have been obvious at the time of the invention

to have implemented this well known feature in Katagishi's system because it enables the predictable result of transmission and recovery of the desired information.

10. Regarding claim 4, Katagishi teaches the telephone in accordance with claim 1. Although Katagishi does not explicitly teach the telephone wherein the region information is transmitted from a telephone of the callee represented by an electronic mail, and the acquiring unit acquires the region information by receiving from a telephone of the callee an electronic mail in which the region information is described. Sending particular information in an electronic mail through mobile communication is a technique well known in the art; it would have been obvious at the time of the invention to have implemented this well known feature in Katagishi's system because it enables the predictable result of transmission of desired information in a well known alternative way, which IP based data communication.

11. Consider claims 14, 22, 30, and 33, Katagishi teaches the telephone system, the method, the computer program and its corresponding recording medium in accordance with claims 13, 21, 29, and 32 respectively, wherein
the specification information is received from the second telephone as a callout request to the first telephone (See [0034] on page 3 lines 2-7), and
the display processing comprises the further step of:
calling, in the telephone network, the first telephone if an instruction from the second telephone after notifying the region information to the second telephone is not received (See [0052], lines 5-19, see also figure 16 at step 704).

Katagishi fails to disclose that calling the first telephone occurs when there is no instruction from the second telephone after a predetermined time period elapses. However, the examiner takes official notice that it is well known in the art to implement a timer to test for condition of whether the notification of the region information has been received. It would have been obvious to one ordinary skill in the art at the time the invention was made to test for the condition in Katagishi's invention because ti would enable the caller a time to asses timing circumstances of the called party and make decision of whether to contact or not, rather than contacting automatically or without any exceptions.

Response to Arguments

Applicant's arguments filed 10/28/2008 have been fully considered but they are not persuasive.

Regarding claims 23, 29, and 30 the examiner respectfully disagrees with the assertions and arguments made by the applicant. The applicant submits that claims 23-30 recites patentable form of a computer program that is implicitly associated with a computer readable medium and therefore the aforementioned claims are in condition to conform to the requirement of 35 U.S.C. 101. While the computer program as disclosed produces “a useful, concrete, and tangible result” in addition to a proper structure, the examiner however acknowledges the applicant that the computer is directed to execute the instruction as claimed without explicit indication in which element of the system is

physically stored to be executed. Thus, it is fails to fully conform to 35 U.S.C. 101 requirements. Thus, the rejection is maintained.

Regarding claims 1, 5, 6, 13-15, 21-23, 29, and 30 the examiner respectfully disagrees with the traverse or arguments made by the applicant.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. ability to identify time zone to which the telephone of the callee belongs and calculate the local time of the locality of the callee with use of (i) the time difference between the time zone to which the telephone of the callee belongs and a time zone to which the telephone of the caller belongs and (ii) the time counted by the telephone of the caller. This beneficially makes it possible to calculate the local time of the locality of the callee based on the pre-stored region information, without taking the trouble to access the base station with which the location of the telephone of the callee is registered) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claims 1, 15, and 23 particularly, the applicant submits that Katagishi does not disclose nor suggest a method judging whether a callee's telephone is capable of roaming, however the examiner acknowledges the applicant that Katagishi suggests a method that solves the problem of providing a local time to callers calling a user who is a nomad or roams from a home region to another region with different time zone. As suggested by Katagishi, said user who travels from one region to another is equipped

with a mobile device which has roaming capability as well as cellular mobile infrastructure supporting such capability of said mobile device. Thus, Katagishi's invention or suggested method is necessarily equipped to judge and detect roaming occurrence or movements of the user as provided by said cellular system infrastructure. Moreover, Katagishi's invention is directed towards providing local time of callees in international zones, therefore callees are carrying devices that are international roaming capable served by wireless systems that manage the operation of such roaming including detecting and judging a callee outside its home region (See above rejection). Note that Katagishi's invention includes a time recognition unit that obtains local time of a callee using time information received from either receiving end unit or base station (See abstract, lines 3-6).

The applicant also asserts that Katagishi does not disclose anything about a telephone of the caller storing therein region information of the callee in association with identification information identifying the callee or a telephone number. However, the examiner respectfully would like to direct the applicant's attention to [0035], lines 9-16, where Katagishi explicitly teaches that time information can be retrieved from pre-stored information that is linked to a previously stored phone number (Se [0043], lines 10-11). Therefore, Katagishi teaches a storage unit operable to store the telephone number and identification information identifying the callee of the telephone number, and the corresponding region information.

The applicant on the other hand does not explain how the telephone number or identification information that is pre-stored in the caller unit would give accurate location

time of the callee if the callee is mobile phone user. In this instance the caller might retrieve a time zone associated with the user home region but the user might be in an area that is hours away with different time zone.

Regarding claims 5 and 6, the applicant submits that said claims are allowable in view of their dependency; however, the applicant respectfully disagrees as said claims at least inherit the deficiency of their independent claim 1.

In regards to claims 13, 21, and 29 the applicant asserts that the claims have the same structure as claims 1, 15, and 23 respectively, however, the examiner acknowledges that said claim are similarly anticipated by Katagishi, and therefore not allowable.

Regarding claims 14, 22, and 30 the applicant submits that Katagishi does not disclose the call unit of claim 14, or calling step of calims 22 and 30. The examiner respectfully disagrees and acknowledges that such teaching is taught by Katagishi (See [0052], lines 5-19, see also figure 16 at step 704), Katagishi might not explicitly teach calling the first telephone occurs when there is no instruction from the second telephone after a predetermined time period elapses.

However, the examiner acknowledges that it is well known in the art to implement a timer to test for condition of whether the notification of the region information has been received because it would enable the caller a time to asses timing circumstances of the called party and make decision of whether to contact or not, rather than contacting automatically or without any exceptions.

Regarding claims 3 and 4, the applicant submits that the claims are not taught by Katagishi and that they are allowable also in virtue of their dependency of claim 1. The examiner however, reasserts above teaching as indicated in the rejection in addition to their inheritance of the deficiency of claim 1.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ISSAM CHAKOUR whose telephone number is (571) 270-5889. The examiner can normally be reached on Monday-Thursday (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Perez Rafael can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/I. C./
Examiner, Art Unit 2617

/Rafael Pérez-Gutiérrez/
Supervisory Patent Examiner, Art Unit 2617